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THE TTAB

Mailed: September 14, 2005

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Grendene, S.A.

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Serial No. 78196985

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Mark S. Graham of Luedeka, Neely & Graham, P.C. for  
Grendene, S.A.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law  
Office 105 (Thomas G. Howell, Managing Attorney).

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Before Seeherman, Chapman and Kuhlke, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Grendene, S.A., a Brazilian corporation, has filed an  
application to register the mark shown below for "plastic  
thong sandals" in International Class 25.<sup>1</sup>



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<sup>1</sup> Application Serial No. 78196985, filed December 20, 2002, alleging a bona fide intent to use the mark in commerce. The application includes the following description: "The mark consists of the word Ipanema adjacent to a design depicting the sun rising over water within a circle." The word "Ipanema" is disclaimed.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resembles the registered marks IPANEMA (standard character form) for "swimwear" in International Class 25,<sup>2</sup> and IPANEMA (standard character form) for "footwear" in International Class 25,<sup>3</sup> as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, and there has been no oral hearing.<sup>4</sup> We affirm the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201

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<sup>2</sup> Registration No. 1778404, issued June 22, 1993 to Made in Brazil, Inc., assigned to James W. Brady and Patricia M. Brady, Section 8 affidavit accepted and Section 15 affidavit acknowledged, renewed.

<sup>3</sup> Registration No. 1908543, issued August 1, 1995 to Ipanema Shoe Corp. ultimately assigned to Consolidated Shoe Company, Inc., Section 8 affidavit accepted, renewed.

<sup>4</sup> Applicant's petition to accept its late-filed request for an oral hearing was denied in a June 17, 2005 decision by the Commissioner for Trademarks.

(Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of the goods identified in the application and the respective registrations. It is well settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods themselves, but rather whether purchasers are likely to confuse the source of the goods. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, we must consider the cited registrants' goods as they are described in the registrations and we cannot read limitations into those goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade

or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

With regard to "footwear" as identified in Registration No. 1908543, because the identification of goods in the registration is not limited to specific types of footwear or to specific channels of trade, it must be presumed that the footwear encompasses footwear of all types, including plastic thong sandals, and that they are sold through all types of outlets that deal in footwear. Accordingly, for purposes of the likelihood of confusion analysis, applicant's sandals, because they are encompassed within the identification "footwear," must be considered legally identical to this cited registrant's goods and must be deemed to be sold in the same channels of trade.

Applicant's statement that its "understanding that the owner of the '543 registration actually has used the mark (if at all) only for women's dress shoes of high fashion" (brief p. 8), is not persuasive. An applicant may not restrict the scope of the goods covered in the registrant's registration by extrinsic evidence or, in this case, a mere

unsupported statement. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Further, applicant's arguments that the identification "footwear" is "of course far too broad and is akin to the many highly problematic registrations issued some years ago for computer programs"; and that "it is applicant's understanding that the Trademark Office has been somewhat more lenient in considering the specific nature of the products" (brief p. 8), are also unpersuasive. The Trademark Acceptable Identification of Goods and Services Manual contradicts applicant's position in that "footwear" is listed as an acceptable identification, whereas "computer programs" is not acceptable.

With regard to "swimwear" as identified in Registration No. 1778404, the examining attorney has presented evidence of a relationship between swimwear and plastic thong sandals through third-party registrations showing that entities have registered a single mark for both swimwear and sandals. See, for example, Reg. Nos. 2773719, 2771726, 2750409, 2735699, and 2686685. Third-party registrations which individually cover a number of different items, and which are based on use in commerce, serve to suggest that the listed goods are of a type which may emanate from a single source. See *In re Albert Trostel*

& Sons Co., 29 USPQ2d 1783 (TTAB 1993). In addition, it is common knowledge that thong sandals are the kinds of goods that are worn with swimwear; therefore, the goods are complementary. Further, these goods can be sold in the same channels of trade, for example, stores specializing in beach apparel. Applicant has stated that "swimwear products are typically purchased from a specialized clothing store or a special section of a department store"; and that it "is unlikely that any selection criteria would be common between the consumers seeking swimwear and consumers seeking plastic thong sandals." Brief p. 8. However, given the fact that swimwear and plastic thong sandals can be worn together, they are likely to be sold in close proximity and purchased on a single shopping trip. Thus, applicant's unsupported statements do not serve to rebut the examining attorney's prima facie case that these goods are highly related.

In view of the above, the du Pont factors of the similarity of the goods and the channels of trade favor a finding of likelihood of confusion as to both registrations.

We turn then to a consideration of the marks. We find that applicant's mark is highly similar to each of the cited marks. The literal portion of applicant's mark

incorporates the entirety of the registrants' marks. Although the word IPANEMA has been disclaimed by applicant, it still forms a part of the mark and must be considered in the likelihood of confusion analysis. Moreover, because it is the word portion of applicant's mark by which consumers will call for the goods, we find that, despite the fact that it has been disclaimed, it is the dominant element of the mark. In re Dakin's Miniatures Inc., 59 USPQ2d 1593, 1596 (TTAB 1999). The sound and connotation of the marks are identical. The appearance of applicant's mark is slightly different from the marks in both registrations due to the presence of the design element and minimal stylization in applicant's mark; however, the commercial impression is very similar due to the identity of the word portion of applicant's mark with each of registrants' marks. Applicant's design and stylization simply do not create a dissimilarity sufficient to distinguish applicant's mark from the cited marks. Thus, the factor of the similarity of the marks also favors a finding of likelihood of confusion.

In making this finding, we have considered the relative weakness of the marks, in particular with regard to swimwear and plastic thong sandals, inasmuch as Ipanema is a well-known beach in Brazil and applicant has

disclaimed the word based on the examining attorney's determination that "applicant's goods come from Ipanema." Final Office Action p. 3. Applicant contends that "it is logically and legally inconsistent to assert on the one hand that the term 'Ipanema' does not function to identify a source of Applicant's goods, and to assert on the other hand that use of the term in Applicant's mark would give rise to confusion as to the source of Applicant's goods" (brief p. 2.). However, marks are considered in their entirety for purposes of likelihood of confusion analysis and, as stated above, a disclaimer does not obviate a likelihood of confusion. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Moreover, even weak marks are entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); Hollister Incorporated v. IdentAPet, Inc., 193 USPQ 439 (TTAB 1976).

Also unpersuasive is applicant's argument that "applicant's mark is far more different from the mark of the '404 registration than is the mark of the '543 registration" and it "is a matter of simple common sense that applicant's mark should be registered over these two



marks, otherwise, they cannot be said to be appropriately registered over each other." The Board is not bound by prior decisions of examining attorneys, but must decide each case on its own merits. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Finally, applicant's argument under Section 33(b) that it has a right "to disclose the geographic origin of [its] goods in [its] mark by the use of terms...indicative of geographic origin," (brief p. 6) is irrelevant in an ex parte proceeding. "The 'fair use' defense is only available in an action charging infringement of a registered trademark and is only viable in that context where the defendant's use has been fairly made, in good faith, to describe to users the goods."<sup>5</sup> Miles Laboratories v. Naturally Vitamin Supplements, 1 USPQ2d 1445, 1454 (TTAB 1986). Thus, the defenses set forth in Section 33 of the Trademark Act apply to civil infringement actions regarding use,

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<sup>5</sup> Applicant's assertion of a potential conflict between Section 33(b)(4) and Section 2(d) is misplaced. The question is not one of "fair use" but rather of registrability of a proposed trademark. In addition, applicant seems to believe that its geographically descriptive term Ipanema is "unregistrable." Geographically descriptive marks are registrable upon a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. See §§ 2(e)(2) and 2(f) of the Trademark Act, 15 U.S.C. §§1052(e) and (f). Acquired

not registrability questions before this Board. The Board is only empowered to decide questions of registrability. See Sections 17, 18, 20 and 24 of the Trademark Act; and TBMP Section 102.01 (2d ed. rev. 2004).

In conclusion, we find that because the marks are similar, the goods are the same and/or closely related, and the channels of trade are the same or overlapping, confusion is likely between applicant's mark and both of the cited registrations.

**Decision:** The refusal to register is affirmed as to both of the cited registrations.

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distinctiveness has not been asserted in this application and is not an issue before us on appeal.